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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/809,406

03/26/2004

Hajime Inada

119285

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25944

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12/01/2009

OLIFF & BERRIDGE, PLC

P.O. BOX 320850

ALEXANDRIA, VA 22320-4850

EXAMINER

THOMPSON, JAMES A

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

12/01/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

***Response to Arguments***

Applicant's arguments filed 19 November 2009 have been fully considered but they are not persuasive.

*Applicant argues* that Margalit (US-6,763,399) and Tomita (US-2003/0035124) not have rendered obvious a "function implementing unit that, when instruction data is stored in the storing unit via the interface the external personal computer, automatically reads the instruction data, determines a process to implement one of the one or more functions corresponding to the read instruction data and executes the determined process," as recited in independent claim 1. Specifically, Applicant contends that Margalit and Tomita are not properly combinable since, allegedly, Tomita teaches operates with respect to a printer and would thus render the device of Margalit unsatisfactory for its intended purpose.

*Examiner replies* that Examiner has not relied upon the printing functions taught by Tomita, but merely on the teaching regarding automatically reading instruction data, determining a process to implement one of the one or more functions corresponding to the read instruction data, and executing the predetermined process, as taught in paragraph 100 of Tomita.

While Tomita performs the above with respect to a printer, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

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Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Examiner applies Margalit as the primary reference and then turns to Tomita to determine what would have been an obvious modification for one of ordinary skill in the art at the time of the invention. Tomita teaches automatically reading instruction data, determining a process to implement one of the one or more functions corresponding to the read instruction data, and executing the predetermined process. While Tomita applies this teaching to printers, the teaching can also be applied to the USB device disclosed in Margalit since nothing within the specifically applied teachings from Tomita must necessarily be applied to printers.

In conclusion, Applicant has not shown Examiner's rejection to be defective. Therefore, the final rejection of 19 August 2009 is maintained.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is (571)272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571-272-7402. The fax phone number for the

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organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A Thompson/  
Primary Examiner  
Art Unit 2625

22 November 2009